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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,799	07/28/2003	Markus Hamulski	HAMULSKI AL-5	4531
25889	7590	02/15/2008		
COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			EXAMINER DESAI, ANISH P	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 02/15/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/628,799	<b>Applicant(s)</b> HAMULSKI ET AL.	
	<b>Examiner</b> ANISH DESAI	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 8-15 is/are pending in the application.
- 4a) Of the above claim(s) 14 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. In view of the Appeal Brief filed on 11/08/07, **PROSECUTION IS HEREBY REOPENED.**

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution  
(Signature below).

2. Claims 1-5 and 8-15 are pending, claims 6 and 7 are cancelled, and claims 14 and 15 are withdrawn.
3. The 35 USC Section 103(a) rejections based on Koga et al. (EP 0661364) (US equivalent Koga et al. US 5,567,515) taken individually, or in view of Schurb (US 5,496,601) are withdrawn in view of the of the present amendment and response. Koga taken alone does not teach or suggest “an adhesive layer consisting of a styrene block copolymer and at least one polyolefin, said at least one polyolefin being selected from the group consisting of polyethylene and polypropylene” as claimed. Further, there is no reason to replace the alpha-olefin copolymer

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of Koga with the polyolefin adhesive based components of Schurb, because the primary reference of Koga requires that alpha-olefin copolymer be present in his invention.

4. A new 35 USC Section 102(b) or 103(a) rejection based on Hisao (Machine translation of JP 08-324676) is made.

***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 5, and 8-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hisao (Machine translation of JP 08-324676).

Regarding claims 1-3, 8, and 10 Hisao teaches a cover tape (self-adhesive surface protection film) for packaging electronic parts. The cover tape 1 of Hisao includes a layered laminate including a biaxially oriented film 2 (carrier layer) and a sealant layer 4 (adhesive layer) that is made of a mixture of polyethylene or polypropylene with a hydrogenated styrene-isoprene-styrene block copolymer (abstract and 0003). The biaxially oriented film (carrier layer) of Hisao is formed of polyester, polypropylene or nylon (0004). Further, Hisao is silent as to

teaching that the styrene block copolymer of his invention is plasticized with oils or resins.

Additionally, the thickness of the biaxially film is from 5 to 30 microns (0005) and the thickness of the sealant layer is from 5-30 microns (abstract).

As to the claim requirement of layered laminate produced by coextrusion, this limitation is related to product by process limitation. The product by process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. "Even though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir.1985).

Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983). In the instantly claimed subject matter, the self adhesive film of Applicant includes a layered laminate comprising a carrier layer and an adhesive layer; wherein the adhesive layer of Applicant consists of a composition as set forth in claim 1. The self adhesive film of the prior art of Hisao is previously disclosed and it includes a layered laminate comprising a carrier layer and an adhesive layer having the same composition as that of Applicant. Therefore, the products of the prior art and that of Applicant are structurally and compositionally equivalent.

As to claim 5, although Hisao is silent as to teaching the claimed property of the adhesive strength as set forth in claim 5, it is reasonable to presume that said property is present in the adhesive tape of Hisao. The support for said presumption is based on the fact that the products of Hisao and that of Applicant comprise a carrier layer and an adhesive layer of identical composition as set forth in claim 1. Therefore, the products of Hisao and that of Applicant are structurally and compositionally equivalent. Thus, the presently claimed property of the adhesive strength would be present. The burden is shifted to Applicant to prove it otherwise (*In re Fitzgerald*, 205 USPQ 594).

Regarding claim 9, Hisao seem to teach anchor coat layer that is between the biaxially oriented film (carrier layer) and the sealant layer (adhesive layer) (0007). Alternatively, it is known in the adhesive tape art to provide a layer of bonding agent (primer layer) between backing (carrier) and an adhesive to improve delamination strength between the adhesive and carrier. Therefore, it would have been obvious to one of ordinary skill in the art to include a primer layer, tie coat or anchor layer in the composite of Hisao motivated by the desire to improve the bonding between the backing and the adhesive.

6. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hisao (Machine translation of JP 08-324676).

As to the claim requirement of di-block content of less than 1% by weight, Hisao discloses claimed invention except for the di-block content, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select the optimum range of

the di-block content in the invention of Hisao, since doing so would involve routine skill in the art.

7. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hisao (Machine translation of JP 08-324676) in view of Cray et al. (US 2002/0061998A1).

Hisao is silent as to teaching a release layer as claimed. However, Cray discloses silicone release coating compositions that are useful in applications where relatively non-adhesive surfaces are required, for example backing papers for PSA labels (abstract and 0003). Further, the release coating compositions of Cray includes additives such as chalk (0063). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the release coating of Cray in the invention of Hisao, motivated by the desire to easily unwind the adhesive film from a roll.

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hisao (Machine translation of JP 08-324676) in view of Cray et al. (US 2002/0061998A1) as applied to claim 11 above, and further in view of Mazurek et al. (US 5,650,215).

Hisao is silent with respect to teaching the release layer having a micro-embossed surface produced by an embossing roller. However, Mazurek discloses pressure-sensitive adhesive tape having microstructured adhesive (abstract and drawings). Further, Mazurek discloses a microstructured release liner (column 5 lines 5-6), which reads on micro-embossed surface as claimed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to micro-embossed the surface of the release layer, because an adhesive tape with such a release layer would be easier to unwind from a roll without release layer sticking to the surface of the adhesive layer. As to the requirement of micro-embossed surface produced by

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an embossing roller, for the same reasoning as set forth in the Section 5 applies to this limitation since the examiner recognizes it as a product by process limitation.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The US 5,387,208 to Ashton et al. discloses an absorbent article having a hot melt adhesive that is a mixture of polyethylene or polystyrene with A-B-A block copolymers such as SIS block copolymer (abstract and column 26 lines 40-44).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANISH DESAI whose telephone number is (571)272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. D./

Examiner, Art Unit 1794

APD

/Terrel Morris/

Terrel Morris

Supervisory Patent Examiner

Group Art Unit 1794